

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alberth, Jr. et al.)
For: A Method and System for)
Maintaining Registration)
Information for Multiple)
Communication Areas)
Serial No.: 10/749,819)
Filed: December 31, 2003)
Examiner: Levitan, D.)
Art Unit: 2616)

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed with this request. The present request is being filed in conjunction with a notice of appeal. The review is being requested for the reasons stated below, which frames the issue to be considered as part of the pre-appeal review process.

The Examiner continues to reject claims 1-6, 8-10, 12-14 and 16-21 under 35 USC §112, first paragraph, as allegedly failing to comply with the written description requirement; claims 1-6, 8-10, 12-14 and 16-21 under 35 USC §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention; and claim 11 under 35 USC §103(a) as allegedly being unpatentable over Selby, US Patent No. 4,876,738, in view of Chen et al., US Patent No. 6,922,561, and further in view of Lawrence, US Patent No. 6,628,935. However contrary to the Examiner's assertions, the claims are patentable over the references the Examiner relies upon in support of any art rejections, the claims comply with the written description requirement and particularly point out and distinctly claim the subject matter which the applicants regard as the invention (i.e. the claims are definite).

With regard to the allegations of failure to comply with the written description requirement under 35 USC §112, first paragraph, relative to claims 1-6, 8-10, 12-14 and 16-21, where the Examiner more specifically objected to the incorporation of features in independent claims 1 and 12, which the Examiner individually associates with separate embodiments. The Examiner objects to claimed combination of features, where the Examiner assert that the features were not disclosed as a combination focusing on the embodiments illustrated in FIG. 5 and FIG. 6 of the drawings, and presumably the corresponding description in written portion of the specification. More recently, the Examiner has supplemented the portions of the description alleged to be associated with the respective embodiments illustrated in FIGS. 5 and 6, to additionally refer to FIGS. 1 and 2 (however the inclusion of FIGS. 1 and 2 appear to be in error, as they relate to an exemplary wireless communication system and portion of an exemplary network, and do not directly correspond to the respective flow diagrams of a method associated with FIGS. 5 and 6).

Nevertheless, the Examiner appears to ignore other portions of the written specification, which discusses the interaction (i.e. combination) of the two sets of features, as part of the discussion of the portion of the exemplary network illustrated in FIG. 2. More specifically, the two sets of features and the interaction thereof is expressly discussed in connection with the written description corresponding to FIG. 2 (page 5, line 26 to page 6, line 26). Furthermore, the claims in question and the corresponding combination of features was the subject of claims that were present in the application as originally filed. More specifically claim 7, which was dependent upon claim 1, and claim 15, which was dependent upon claim 12, contained the corresponding combination of features as originally filed (please note the alleged offending amendment of claim 1 involved the incorporation of the dependent features of claim 7, and the alleged offending amendment of claim 12 involved the incorporation of the dependent features of claim 15 – As part of the amendment of claims 1 and 12, claims 7 and 15 were cancelled). Consequently, contrary to the Examiner's assertions it would have been clear to one skilled in the art, at the time the application was filed, that the inventors had possession of the claimed invention, as the combination of features was the subject of a claim in the application as originally filed, and was discussed as a combination in at least the above noted section of the specification. Given the discussion of the claimed combination from the specification and the fact that the amendment represents the inclusion of a dependent feature from a dependent claim

into the respective independent claim from which it originally depended, contrary to the Examiner's assertion, the specification reasonably conveys to one skilled in the art, the fact that the applicant had possession at the time the application was filed of the currently claimed invention.

The Examiner has additionally and/or alternatively rejected the same claims (i.e. claims 1-6, 8-10, 12-14 and 16-21) as being indefinite under 35 USC §112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter that applicants regards is the subject matter. More specifically, the Examiner has focused upon the claimed registration associated with a first and a second communication [area], and the potential registration associated with entering a new communication area. The Examiner has suggested the possibility of a conflict without explaining the circumstances in which a conflict will or may occur. The applicants would assert that there is no such conflict. More specifically, the claim calls for at least two communication areas, which could correspond to multiple paging areas, such as paging zone ID 108A and paging zone ID 108B within a paging group as illustrated in FIG. 2, which would allow for retaining multiple registrations. There is no conflict between the first and the second communication areas and the new communication area in so far as they define different things. As noted above the first and second communication areas define multiple communication areas, while the new communication area refers to a communication area into which the wireless communication device is moving or has recently moved as related to the communication area that the wireless communication device has recently left, where the claims define the new communication area relative to an immediately prior communication area. In some instances, there can be overlap, where at different times the first, the second, or a still further communication area could also be the new communication area, depending upon if the first, the second, or the still further communication area represents a communication area into which the wireless communication device is moving into or has recently entered. Depending upon whether the new communication area is associated with a different paging group from the paging group associated with the immediately prior communication area may dictate whether a registration associated with entering the new communication area is made relative to the new communication area. As such, the applicants can not identify the conflict being alleged by the Examiner, as there would appear to be no conflict, as the corresponding definitions (first and second vs. new) are not necessarily mutually exclusive. Consequently, contrary to the

Examiner's assertions there is no conflict and therefore the claims are not indefinite, nor do they fail to particularly point out and distinctly claim the subject matter of the claimed invention.

Regarding the Examiner's concerns with respect to FIGS. 1 and 2, it is noted that by way of example FIG. 1 shows a grouping of three cells identified by reference number 108, which is then cross referenced relative to a packet zone ID in FIG. 2, thereby providing a corresponding relationship relative to element in the two figures. A corresponding textual description in the application further clarifies the above noted relationship (see page 4, line 29 to page 5, line 2).

In affirming the previously articulated rejection of claim 11, as allegedly being unpatentable over Selby, US Patent No. '738, in view of Chen et al., US Patent No. '561, and further in view of Lawrence, US Patent No. '935, the Examiner reiterates his prior rejection and simply states a disagreement with the applicants' position, suggesting a clear deletion of stored messages, as allegedly being shown by the reference (ignoring for now the fact of the contextual inconsistencies, where the reference refers to messages as opposed to the maintenance of registration information). Furthermore, as previously indicated, Lawrence does not provide for the deletion of stored messages upon power up/down, but alternatively teaches providing a change in indicator status, which alerts the user of the low memory status, which the Examiner then asserts does not contradict the teaching of a deletion, but also does not teach and or otherwise provide the teaching being attributed to the reference, where the claimed cause and effect associated with the present application is clearly defined. Furthermore, the type of message is not irrelevant, despite being associated with a type of claim corresponding to a method, because the claimed method is directed to a particular environment involving the maintenance of registration information, which provides for the conditions under which registration information is discarded, which is not similarly taught or suggested by the reference. The Examiner is reminded that each and every feature of the claim needs to be accounted for including the claimed elements as well as the claimed relationship between the elements. The Examiner has not met his burden of accounting for each and every feature of the claims, whether it is shown to be expressly taught or whether it has been shown or reasonably asserted to be suggested, and therefore the rejection has not been fully supported.

In view of the above noted comments regarding the Examiner's express reasoning, the applicants would continue to maintain that with respect to claim 11, and the Examiner's assertion that Lawrence, '935, makes known the deletion of messages upon a change in power

states, the Examiner's assertion can not be supported. Furthermore the teaching relied upon by the Examiner in support of the rejection does not relate to a context consistent with the claimed invention. More specifically, contrary to the assertions of the Examiner, Lawrence, '935, fails to teach the deletion of messages, but alternatively teaches the deactivation of a memory exceed indicator (see col. 2, lines 12-34). In the particular embodiment discussed, even though the memory exceed indicator is deactivated upon power up, if undeliverable messages are subsequently detected the memory exceed indicator will be re-activated (see col. 6, lines 16-40).

Furthermore the teachings of the reference relate to a system associated with SMS type paging messages, which are not the same as the maintenance of registration information associated with a previous presence in a new area. Even if the reference were to teach the deletion of a message upon power up, which it does not, the Examiner is not allowed to allege a teaching which goes beyond the actual teaching. In other words the nexus has not been shown between an e-mail type textual message sent to a user and the maintenance of registration information. The Examiner is not allowed to expand the teaching beyond what the reference actually teaches, through the use of creative re-labeling of the elements associated with the actual teaching (a re-labeling that is not part of the actual language of the original reference, nor could it be equated through any alleged reasonable suggestion beyond the scope of an actual express teaching). Nevertheless, the Examiner can not even show that any information is deleted upon power up (even the memory exceed indicator is not deleted, alternatively its value is only changed). As a result, the references being relied upon in support of the rejection of claim 11, can not be said to make known or obvious each and every feature of claim 11.

The other references being relied upon by the Examiner fail to account for the above noted deficiency. In view of the above remarks, the applicants would respectfully request that the Examiner's final rejection of the claims be withdrawn, as failing to make known or obvious each and every feature of the claims.

Respectfully submitted,

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